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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,444	11/03/2005	Ralph Brandes	277672US0XPCT	4353
22850	7590	04/23/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MARCHESCHI, MICHAEL A	
			ART UNIT	PAPER NUMBER
			1793	
			NOTIFICATION DATE	DELIVERY MODE
			04/23/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/555,444	<b>Applicant(s)</b> BRANDES ET AL.	
	<b>Examiner</b> Michael A. Marcheschi	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/3/05, 6/15/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

Applicant's election with traverse of Group I, claims 1-4 in the reply filed on 2/15/08 is acknowledged. The traversal is on the ground(s) that no serious burden is required. This is not found persuasive because the restriction applied is under 35 U.S.C. 121 and 372 (groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.) and applicants arguments are not directed to this type of restriction (i.e. 371 restriction) but rather a conventional restriction of a US application not based on 371 status. The reasons for restriction clearly stated that "the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1 is either anticipated or obvious over Menzel et al. (156). Accordingly, the special technical feature linking the two inventions, the dispersion of claim 1, *does not provide a contribution* over the prior art, thus no single general inventive concept exists and restriction is appropriate". Since the "serious burden" argument is not pertinent to a 371 restriction, no further comment is necessary.

The requirement is still deemed proper and is therefore made FINAL.

However, the examiner will considered rejoinder of the non elected invention when it is appropriate to do so.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is indefinite because the examiner is unclear as to what the additives are.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Menzel et al. (156).

The reference teaches in the abstract and sections 0012-0030, an aqueous dispersion having a pH of 4-12.4 (i.e. can be literal value of 4) comprising 1-30 weight percent silicon-aluminum mixed oxide having a surface area of 50-200 m<sup>2</sup>/g, wherein the aluminum oxide content is 0.1-99.9 weight percent (i.e. can be literal values of 0.1 or 99.9 weight percent), wherein the powder has a structure consisting of amorphous silicon dioxide regions (claim 1). The dispersion can also contain additives, such as an oxidizer and other particles, such as silica doped with alumina.

In view of the above teachings, the claimed invention is anticipated by the reference because the reference teaches a composition which comprises all of the claimed components

along with the claimed specific surface area, pH and alumina proportions. With respect to the last limitation of claim 1, the reference powder has a structure consisting of amorphous silicon dioxide regions (claim 1), thus this teaching shows that no signals for crystalline silicon dioxide are apparent. With respect to the surface characteristics of the powder (i.e. surface zone), since the method is the same, the same results are expected and thus inherent absent clear evidence to the contrary.

With respect to claim 4, the dispersion of the reference also contains other particles, such as silica doped with alumina and this reads on silica particles defined in instant claim 4 because it is a silica particle and the claim does not distinguish this from a silica doped particle.

In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention absent evidence to the contrary because the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see ***In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)**. With respect to the surface characteristics of the powder (i.e. surface zone), since the method is the same, the same results are expected and thus obvious because the same method obviously produces particles having the same characteristics absent clear evidence to the contrary.

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as obvious over Menzel et al. (156), as applied to claim 1 above and further in view of Schroeder et al. (763).

The rejection of claim 4 is an alternative rejection to the ones defined above.

With respect to claim 2, the primary reference teaches that the dispersion contains an oxidizer and although the amount is not defined by the primary reference, this is obvious because it is the examiners position that the lack of an amount for the oxidizer implies that any conventional amount for this component can be used as long as it provides the necessary oxidizing characteristic. In view of this, one skilled in the art would have found it obvious to use any known conventional amounts, such as those defined by Schroeder et al. in section 0035, because this amount is conventionally known to provide the necessary oxidizing characteristic to polishing compositions, which is what the dispersion of the primary reference is used for.

With respect to claim 4, polishing compositions are generally known to contain abrasives and the abrasives can be silica, alumina, etc. and co-formed products thereof (i.e. this broadly reads on co-formed products of silica and alumina, such as a silica/alumina mixed oxide), as shown by Schroeder et al. in section 0018 and thus, it is prima facie obvious to combine two or more materials disclosed by the prior art to form a third material (mixture of abrasive particles) that is to be used for the same purpose. In re Kerkhoven 205 USPQ 1069. In addition, since Schroeder et al. clearly teaches that abrasives for polishing compositions can be a combination of silica and a co-formed product of silica/alumina (i.e. silica/alumina mixed oxide), this further establishes motivation to use this combination in the primary reference.

The references cited on the 1449 have been reviewed by the examiner and are considered to be art of interest since they are cumulative to or less than the art relied upon in the above rejections.

Any foreign language documents submitted by applicant has been considered only to the extent of the short explanation of significance, English abstract or English equivalent, if appropriate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793